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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,900	08/22/2001	John R. Booth	BB1476 US NA	8096

23906 7590 03/25/2003

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LEGAL PATENT RECORDS CENTER  
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EXAMINER

MCELWAIN, ELIZABETH F

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/934,900

Applicant(s)

BOOTH ET AL.

Examiner

Elizabeth F. McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Applicants are reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Upon election of a Group below, Applicant is additionally required to select a single nucleotide sequence, when the group has claims drawn to sequences. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention.

Claims 1-15 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 14-15, drawn to an isolated polynucleotide, a method comprising transforming a host cell, a chimeric construct and a transformed host cell, classified in class 536, subclass 23.2, for example. (If this Group is elected, then applicant must also elect a single nucleotide sequence)
- II. Claim 10, drawn to a method of obtaining a nucleic acid comprising hybridizing a probe and sequencing an isolated DNA, classified in class 435, subclass 6, for example.

- III. Claim 11, drawn to a method of obtaining a nucleic acid comprising hybridizing a probe and expressing the isolated DNA in a bacterial or yeast cell and assaying for activity, classified in class 435, subclass 69.1, for example.
- IV. Claim 12, drawn to a method of identifying an isolated polynucleotide by  
5 determining if the polynucleotide encodes at least two specified amino acid sequences, classified in class 435, subclass 72, for example. (If this Group is elected, then applicant must also elect a pair of amino acid sequences)
- V. Claim 13, drawn to a method of identifying an isolated polynucleotide by  
10 determining that it does not contain one of two amino acid sequences, classified in class 435, subclass 72, for example.

The inventions are distinct, each from the other because:

The inventions of Groups I-V are distinct products and methods, wherein one is not required by the other. The DNA of Group I can be made by a different method other than any  
15 of the methods of Groups II-V, and the methods of Groups II-V can make a DNA other than any of those claimed in Group I. In addition, each of the methods of Groups II-V are distinct, requiring different components and using different method steps. Thus the inventions of Groups I-V are each capable of being separately made, independently used and the patentability of one would not render the other obvious or unpatentable.

20 Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent

subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an  
5 election of the invention to be examined even though the requirement be traversed (37  
CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention,  
the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the  
currently named inventors is no longer an inventor of at least one claim remaining in the  
10 application. Any amendment of inventorship must be accompanied by a petition under 37  
CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-  
15 1794. The examiner can normally be reached on Monday through Friday from 8:00 AM to  
4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this  
20 Group is (703) 308-4242. The faxing of such papers must conform with the notice published  
in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be  
directed to the CUSTOMER SERVICE TECH CENTER 1600, whose telephone number is  
25 (703) 308-0198, or to the Group receptionist whose telephone number is (703) 308-0196.

Elizabeth F. McElwain, Ph.D.  
March 20, 2003

  
**ELIZABETH F. McELWAIN**  
**PRIMARY EXAMINER**  
**GROUP 1600**